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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,358	03/12/2004	Edward George Callway	00100.99.1035	7951

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ADVANCED MICRO DEVICES, INC.
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CHICAGO, IL 60606

EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2158

NOTIFICATION DATE	DELIVERY MODE
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04/05/2012

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/800,358	Applicant(s) CALLWAY ET AL.	
	Examiner VINCENT BOCCIO	Art Unit 2158	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-11, 13-21 and 23 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☒ Claim(s) 1-10 is/are allowed.
- 7) ☒ Claim(s) 11, 13-21 and 23 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2158

Response to Amendment/Declaration

In re pages 11-12, applicant states,

"Claims 11-21 and 23 stand rejected as allegedly being based upon a defective reissue oath under 35 U.S.C. 251. Applicants respectfully traverse but submit herewith a supplemental oath/declaration to expedite prosecution."

In response to applicant's Supplemental Re-issue Declaration, provided some addition, Declaration language, such as:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

But, as understood by the examiner, as deemed discussed on the interview, to add language to the Supplemental Declaration, identifying the correction, as encompassed by the present, re-issue (new), claims 11,13-21, 23.

The provided additional language is provided in MPEP but, is generic language that is not deemed to encompass the re-issue claims, defining all corrections, based on the re-issue correction claims 11, 13-21 and 23.

In view of at least the previous amendment, the Supplemental Re-issue in combination the previously filed Declaration 6/21/2004, is deemed not to correctly reflect the current claim corrections.

Since the claims have been amended to include, the Video decoder (amendment Dated 11/23/2011, claims 11, 13-14 and claims 16-18), due to raised recapture, the supplemental declaration, as understood should correspond to the re-issue claims corrected or to correct the initial declaration to directly reflect the

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re-issue claims further amended and therefore, as presently corrected.

Applicant further states,

"Claims 11-14, 15, 16-18, 19-21 and 23 stand rejected under 35 U.S.C. 251 as allegedly being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Although Applicant respectfully traverse, Applicants have amended claim 11 to include **"by a video decoder"** and have amended claim 11 to include claim 12. Applicants have nonetheless amended the independent claims."

In response the recapture issue raised for claims 11-13 and 14, in view of the amendment is dropped.

Applicant also amended claim 16, to include the language, "by a video decoder", therefore, the recapture issue raised for claims 16-18, in view of the amendment is dropped

Applicant further states,

"As to claims 19-21 and 23, Applicants respectfully submit that the language **"prior to..." was actually removed in an office action response in the parent case, namely the office action dated August 7, 2001.** (See for example, prior claims 11, 21). Accordingly, there is no recapture that can apply since this language was not added to the issued claims. Applicants also respectfully submit that the video decoder language is also not the basis for allowance and as such, this is also respectfully submitted not to be recaptured since claims were again rejected under 35 U.S.C. § 103(a) and were allowed for other reasons and the amendment was not made with respect to the 103 rejection. Nonetheless, in order to expedite prosecution, Applicants have amended claims and accordingly, Applicants respectfully request withdrawal of the rejection"

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In response the issue, as understood by the examiner, is that all allows claims 1-10, comprised, the above discussed, limitation.

Therefore, even if once removed, since all allowed claims recite, "prior to enabling CPU access", is deemed amended and argued in combination with all other limitations, as claimed, the combination deemed allowable, as argued by applicant prior to issue.

After a careful consideration of the record the above is deemed to invoke, a recapture of subject matter, as understood by the recapture doctrine, as understood.

Supplemental Re-Issue Declaration Required

Since applicant amended claims after the original reissue declaration filed on 21 June 2004, a supplemental reissue declaration (form PTO/SB/51S) must be submitted prior to allowance.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 11, 13-21 and 23 are rejected as being based upon a defective reissue under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. See MPEP § 1414.01.

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b). In addition, when any substantive amendment is filed in the reissue application, which amendment otherwise places the reissue application in condition for allowance, a supplemental oath/declaration will be required. See MPEP § 1414.01.

Recapture Rejection

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Claims 15, 16-18, 19-21 and 23 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The claims appear to be broadened in scope, against relate, all claims 1-10, of Patent US 6,356,704, application 08/878,249.

Regarding claims 15-21 and 23, are deemed broadened based on a recapture doctrine, for not reciting,

O "prior to, enabling CPU access"

Thus, the above limitations are not deemed to be removable from claims 15-21 and 23, **in the instant reissue application.**

If any one of these limitations is removed from the reissue claim(s), that claim(s) must be rejected under re-capture

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doctrine. See *North American Container, Inc. v. Plastipak Packing Inc.* 415 F.3d 1335, 1349, 75 USPQ2d 1545, 1556 (Fed. Cir. 2005). Consider form paragraph 14.17 when rejecting these claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record Vincent F. Boccio whose telephone number is (571) 272-7373.

The examiner can normally be reached on between Monday-Thursday between (7:30 AM to 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali, can be reached on (571) 272-4105.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system:

"<http://portal.uspto.gov/external/portal/pair>"

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vincent F. Boccio/
Primary Examiner